

## REMARKS

### 1. Status of Claims

Claims 1-10 have been rejected in the Office Action of February 25, 2005. Claims 1-10 are pending. Accordingly, applicant respectfully requests reconsideration and allowance of the application in view of the following remarks.

### 2. Section 103(a) Rejection Over Banker (U.S. Patent No. 5,247,364) in View of Bacon et al. (U.S. Patent No. 5,440,632)

Claims 1-3, 7 and 10 stand rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 5,247,364 to Banker et al. ("Banker") in view of U.S. Patent No. 5,440,632 to Bacon et al. ("Bacon").

The three basic criteria for establishing a *prima facie* case of obviousness, set forth in MPEP § 706.02(j), are listed below:

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure.

*In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Applicant respectfully submits that the criteria mentioned above are not met because Banker in view of Bacon does not disclose or suggest all of the claimed elements of applicant's invention; therefore a *prima facie* case of obviousness has not been established.

Claim 1 recites the steps of "receiving a message designating whether to tune to an in-band or an out-of-band channel for receiving the code object; tuning to the designated channel; and receiving the code object from the designated channel." (emphasis added)

Claim 1 is not obvious in light of Banker or Bacon because Banker appears to merely disclose a method and apparatus for tuning a data channel in an in-band subscription television system, and Bacon appears to merely disclose allowing a subscriber of a subscription television system to be reprogrammed through a download program code

parameters transaction. Neither Banker nor Bacon, however, disclose or suggest “receiving a message designating whether to tune to an in-band or an out-of-band channel for receiving the code object,” as recited in Applicant’s claim 1. In fact, with respect to out-of-band transmissions, Banker only fleetingly addresses such transmission in that “[u]nlike the in-band transactions described in detail below, out-of-band subscriber terminals receive data over this channel no matter what channel the subscriber terminal is tuned to.” [Col. 2, ll. 65-69] (emphasis added) Banker appears to explicitly differentiate out-of-band systems from in-band systems and, with the exception of its fleeting mention of out-of-band systems (as mentioned above), only contemplates use of the disclosed apparatus with respect to an in-band system. Thus, Banker’s “tuning field which instructs the terminal which data channel to tune to receive the message,” apparently is only concerned with “in-band” channels, a very distinct difference from Applicant’s invention.

Additionally, the Examiner states that, “[b]oth Banker and Bacon are directed towards distribution of data via in-band or out-of-band channels to a set top box in a video distribution system environment.” [Office Action, p. 3] (emphasis added) Applicant respectfully and strongly disagrees with this assertion. Contrary to Examiner’s assertion that “[t]he tuning data describes whether to tune to an in-band or out-of-band channel,” [Office Action, p.3] Banker specifically claims a “subscriber terminal apparatus for a television in an in-band subscription television,” wherein a “tuner control tunes the tuner to a channel having in-band data when the display of characters is provided on the television” [Banker Abstract] (emphasis added). Thus, it would not have been “obvious to one of ordinary skill in the art to extend the functionality of Banker with downloading data,” as Banker’s “functionality” as explicitly disclosed is overwhelmingly directed to “in-band functionality.”

Applicant’s invention includes “receiving a message designating whether to tune to an in-band or out-of-band channel for receiving code object; tuning to the designated channel; and receiving the code object from the designated channel,” and is therefore not directed to mere in-band functionality as Banker appears to be.

Claim 1 is not obvious in light of Banker in view of Bacon because the references fail to disclose or suggest the use of, in particular, “receiving a message designating whether to tune to an in-band or an out-of-band channel for receiving the code object.” Moreover, claims 2 and 3 are dependent on independent claim 1 and likewise include “receiving a

message designating whether to tune to an in-band or an out-of-band channel for receiving the code object.”

The Examiner, in addition, “gives OFFICIAL NOTICE that it is notoriously well known in the art to use CRC check for verification purposes.” [*Office Action, p.5*] Applicant respectfully traverses such a finding.

Claim 10 is dependent on claim 7, which includes “a download control message including a download flag and information related to a download channel frequency, the download flag capable of corresponding to one of an out-of-band channel and an in-band channel.” As stated previously, Banker appears to explicitly differentiate out-of-band systems from in-band systems and, with the exception of cursory mention of out-of-band systems, only contemplates use of the disclosed apparatus with respect to in-band systems.

Thus, it would not have been obvious at the time of Applicant’s invention to one of ordinary skill in the art to use Banker in view of Bacon to achieve Applicant’s invention. Accordingly, claims 1-3, 7 and 10 are not rendered obvious for at least the reasons set out above; these claims are thus patentable.

**3. Section 103(a) Rejection Over Banker (U.S. Patent No. 5,247,364) in View of Bacon et al. (U.S. Patent No. 5,440,632) and Hendricks et al. (U.S. Patent No. 5,990,927)**

Claim 4 stands rejected under 35 U.S.C. § 103(a) as being obvious over Banker in view of Bacon and U.S. Patent No. 5,990,927 to Hendricks et al. (“Hendricks”).

Applicant respectfully submits that the criteria mentioned above are not met because Banker in view of Bacon and Hendricks does not disclose or suggest all of the claimed elements of applicant’s invention; therefore a *prima facie* case of obviousness has not been established.

As stated previously, Banker appears to merely disclose use of a method and apparatus for tuning a data channel in an in-band subscription television system, and Bacon appears to merely disclose allowing a subscriber of a subscription television system to be reprogrammed through a download program code parameters transaction.

Hendricks appears to merely disclose a set top converter box for a television program delivery system, wherein the “set top terminal receives the individually compressed program

and control signals, [thereafter] the signals are demultiplexed, decompressed, converted to analog signals (if necessary) and either placed in local storage . . . , executed immediately, or sent directly to the television screen.” [Col. 10, ll. 52-58] Furthermore, the control information signal is sent to the set top terminal “in the form of a set top terminal control information stream.” [Col. 13, ll. 49-50]

Claim 4 is not obvious in light of Banker in view of Bacon and Hendricks because the references fail to disclose or suggest “receiving a message designating whether to tune to an in-band or an out-of-band channel for receiving the code object.”<sup>1</sup> Claim 4 is dependent on claim 1 and, as such, includes the above-referenced limitation. Moreover, claim 4 adds the step of “designating the in-band or out-of-band channel for receiving the code object by means of instructions to a digital access controller in communication with the set top box.” Applicant again would like to emphasize the fact that Banker explicitly differentiates out-of-band systems with in-band systems and appears to solely disclose in great detail in-band systems.

Thus, it would not have been obvious at the time of Applicant’s invention to one of ordinary skill in the art to use Banker in view of Bacon and Hendricks to achieve Applicant’s invention. Accordingly, claim 4 is not rendered obvious for at least the reasons set out above; claim 4 is thus patentable.

**4. Section 103(a) Rejection Over Banker (U.S. Patent No. 5,247,364) in View of Bacon et al. (U.S. Patent No. 5,440,632), Hendricks et al. (U.S. Patent No. 5,990,927) and Wagner et al. (U.S. Patent No. 5,761,602)**

Claims 5-6 stand rejected under 35 U.S.C. § 103(a) as being obvious over Banker in view of Bacon and Hendricks and in further view of U.S. Patent No. 5,761,602 to Wagner et al. (“Wagner”).

Applicant respectfully submits that the criteria mentioned above are not met because Banker in view of Bacon, Hendricks and Wagner does not disclose or suggest all of the claimed elements of applicant’s invention; therefore a *prima facie* case of obviousness has not been established.

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<sup>1</sup> Applicant presumes that Examiner makes reference to Banker even though, with respect to claim 4, Examiner references the “Leary reference”, which Applicant has disqualified

Claims 5 and 6 are not obvious in light of Banker in view of Bacon, Hendricks and Wagner because they fail to disclose or suggest "receiving a message designating whether to tune to an in-band or an out-of-band channel for receiving the code object." Claims 5-6 are dependent on claim 1 and, as such, include the above-referenced limitation. In fact, claims 5 and 6 likewise add an additional step of "deciding between the in-band or out-of-band channel in response to predetermined parameters related to the cable system" and "deciding between the in-band or out-of-band channel in response to said monitoring," respectively.

The Examiner explicitly states that "the aforementioned combined teaching fails to explicitly disclose the adaptive channel selection based on predetermined factors" [*Office Action*, p.7] Claims 5-6 are not obvious in light of the cited references because they fail to disclose or suggest "receiving a message designating whether to tune to an in-band or an out-of-band channel for receiving the code object." Again, Banker appears to explicitly differentiate out-of-band systems from in-band systems. Indeed, the lack of teaching of the aforementioned referenced combined with Banker's differentiation, do not make Applicant's invention obvious in light of prior art.

Thus, it would not have been obvious at the time of applicant's invention to one of ordinary skill in the art to use Banker in view of Bacon, Hendricks and Wagner to achieve applicant's invention. Accordingly, claim 5 and claim 6, which are dependent on claim 1, are not rendered obvious for at least the reasons set out above; these claims are thus patentable.

**5. Section 103(a) Rejection Over Banker (U.S. Patent No. 5,247,364) in View of Bacon et al. (U.S. Patent No. 5,440,632) in Further View of Wagner et al. (U.S. Patent No. 5,761,602)**

Claims 8 and 9 stand rejected under 35 U.S.C. § 103(a) as being obvious over Banker in view of Bacon and Wagner.

Applicant respectfully submits that the criteria mentioned above are not met because Banker in view of Bacon and Wagner does not disclose or suggest all of the claimed elements of Applicant's invention; therefore, a *prima facie* case of obviousness has not been established.

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as prior art. If such reference is an additional reference, Applicant requests that the Examiner clarify.

Claims 8 and 9 are not obvious in light of Banker, Bacon or Wagner because none of the references, individually or in combination, disclose or suggest "receiving a message designating whether to tune to an in-band or an out-of-band channel for receiving the code object." The Examiner states that the "aforementioned combined teaching fails to explicitly disclose adaptively setting the download flag." Furthermore, in light of Banker (upon which the Examiner heavily relies) differentiating out-of-band systems with in-band systems (Banker, in fact, appears to disclose its invention solely with respect to in-band systems), Applicant's invention is not obvious in light of prior art.

Thus, it would not have been obvious at the time of Applicant's invention to one of ordinary skill in the art to use Banker in view of Bacon and Wagner to achieve Applicant's invention. Accordingly, claims 8 and 9, which are dependent on claim 7, are not rendered obvious for at least the reasons set out above; these claims are thus patentable.

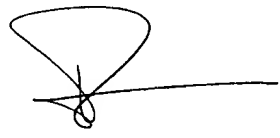
### CONCLUSION

It is respectfully submitted that all claims in the application are now allowable. Reconsideration and withdrawal of the pending rejections are respectfully requested. Early and favorable notice to this effect is earnestly solicited.

If the Examiner does not consider all of the pending claims allowable, the undersigned respectfully requests an interview with the Examiner to discuss the merits of the case.

Respectfully submitted,

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